

## **Remarks**

Claims 24 to 40, 52, 53, and 55 are pending. Favorable reconsideration is respectfully requested.

Applicants respectfully request withdrawal of the finality of the rejection. The present rejection of the claims over *Griesshammer* alone is a new rejection. According to the MPEP and decades of practice, when a new rejection is made, the rejection cannot be made final. See the MPEP §§ 706.7, 706.07(a), 706.07(c), and 706.07(d). This is not a case where a narrowing amendment was made by Applicants which necessitated a new rejection. None of the pending claims were amended. Thus, the finality must be withdrawn.

The claims have been amended to recite that the compounds synthesized are alkylhalosilanes or arylhalosilanes. Each of the reactant mixtures therefore contain a hydrocarbon or organohalogen compound.

*Griesshammer* does not teach or suggest such a process. The process of *Griesshammer* is a process for recovery of trichlorosilane from tetrachlorosilane by reduction of the latter with hydrogen and silicon. Thus, *Griesshammer* reacts silicon metal with a tetrachlorosilane and hydrogen. The claimed invention is very different. Applicants do not react silicon with a halosilane at all! Rather, the reactant claimed by Applicants employs no halosilane reactant. Applicants' claims also require at least one organohalogen compound such as an alkylchloride or arylchloride. *Griesshammer*, however, employs no such reactant. The purpose of *Griesshammer* is to provide high purity trichlorosilane for use in the *Siemens* process to deposit ultrahigh purity silicon. The presence of alkylchlorosilanes or arylchlorosilanes would not allow the recovered trichlorosilane to be employed in this process due to deposition of carbon in addition to silicon. One skilled in the art would therefore not be motivated to employ any organohalogen compounds in *Griesshammer's* process. Rather, the reverse is true. One skilled in the art would be motivated to scrupulously avoid organohalogen compounds in *Griesshammer's* process.

The Examiner states that “replacing one starting material in a chemical reaction with another starting material is a well-known technique in chemical synthesis to optimize the efficiency of the system and does not constitute a patentable invention.” Applicants are unaware of any such premise, whether chemical or legal. The statement appears to be conclusory only, and such conclusory statements cannot be the basis for a rejection. *In re Wagner*, 31 F.2d 877, 152 USPQ 552 (CCPA 1967); *In re Soli* 317 F.2d 941, 137 USPQ 797 (CCPA 1963); see also, *In re Lee* 61 U.S.P.Q. 2d 1430 (Fed. Cir. 2002).

If such a premise were tenable, then there would be few if any patentable inventions in the chemical field. Moreover, as a general chemical premise, it is incorrect. For example, there are many reactions involving organohalogen compounds where a bromo compound is reactive, but fluoro, chloro or iodo compounds either fail to react or react in a completely different manner. Allyl compounds often react completely different from either vinyl compounds or propenyl compounds. Trimethoxysilylpropylureas can be dispersed in water to form stable dispersions, while trimethoxysilylmethylureas rapidly react and gel under the same conditions. Many, many other examples could be recited where substitution of one reactant for another completely fails. If the rejection is maintained, the Examiner must provide a citation which supports this concept, or an Affidavit under 37 C.F.R. § 1.104(d)(2).


However, even if the Office’s assertion were correct, it does not apply to the present case, because the reactions themselves are different. The reaction of *Griesshammer* is a reduction/disproportionation reaction of tetrachlorosilane. Applicants’ reaction is an organylation of silicon with an organohalide or with hydrocarbon and hydrogen halide. No organohalide is even present in *Griesshammer*. Applicants’ reaction involves the scission of a carbon-halogen bond and the formation of a silicon-carbon bond. *Griesshammer’s* reaction does not involve either of these, and the thermodynamics and kinetics of *Griesshammer’s* reaction cannot be reconciled with or compared with the reactions claimed by Applicants.

Entry of the amendment is solicited, since no new claims have been added, since the amendments should place the claims in condition for allowance, and since Applicants have not had an opportunity to address the rejection previously.

Applicants submit that the claims are now in condition for Allowance, and respectfully request a Notice to that effect. If the Examiner believes that further discussion will advance the prosecution of the Application, the Examiner is highly encouraged to telephone Applicants' attorney at the number given below.

Respectfully submitted,

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